

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed on January 26, 2006. At the time of the Office Action, Claims 1-8 and 10-28 were pending and 17-28 were withdrawn. The Examiner rejects Claims 1-8 and 10-16. Applicant amends Claim 1 and cancels Claim 6 without prejudice or disclaimer. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Amendments to the Specification

Applicant has amended the first paragraph on Page 1, lines 2-7 of the Specification as requested by the Examiner. Specifically, Applicant has amended the Specification to include missing information in the Related Patent Application Section.

Double Patenting

The Examiner provisionally rejects Claims 1-16 under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 1-8 and 10-16 are rejected as being unpatentable over Claim 1 of copending Application No. 09/817,353 ("353 Application") in view of U.S. Patent Application Publication No. 2002/0010634 A1 issued to Roman et al. ("Roman") and U.S. Patent Application Publication No. 2001/0032143 A1 issued to Haseltine ("Haseltine"). Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

The Claims are Allowable over the cited References

Claims 1-6 and 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by *Roman*. Additionally, Claims 1, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Roman* in view of *Haseltine*. Because neither *Roman* nor *Haseltine* disclose, teach, or suggest each and every feature of Applicant's claims, Applicant respectfully disagrees.

Independent Claim 1, as amended, recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, a request to initiate return processing, via a web access tool associated with the customer;

accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise;

receiving a selection of an item of merchandise from the list from the customer via the web access tool; and

generating data for printing a return label for the selected item of merchandise.

Thus, Claim 1 has been amended to incorporate certain features previously recited in dependent Claim 6, which has now been canceled. Whether considered alone or in combination, neither *Roman* nor *Haseltine* disclose, either expressly or inherently, each and every element of independent Claim 1.

For example, Applicant respectfully submits that neither *Roman* nor *Haseltine* (nor their proposed combination) disclose, teach, or suggest “accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction,” as recited in Claim 1. With respect to Claim 6 (which recited a step of accessing a database before cancellation in this Response), the Examiner relied upon paragraph 16, line 3 of *Roman* for disclosure of the recited features. However, the cited portion of *Roman* merely discloses that that “ClickReturns.com system automatically analyzes the submitted return for fraud against a proprietary database.” (Page 1, Paragraph 16, lines 1-3). Furthermore, *Roman* specifically provides that information for identifying the return is received from the customer rather than from a database. According to *Roman*, the consumer is asked “a series of questions about the return.” (Page 1, paragraph 15, lines 1-2). Information obtained may include “receipt number, consumer’s name, phone number,

description of the product being returned matching original transaction record collected from the step above, condition of the product, such as original packaging and working condition.” (Page 1, paragraph 15, lines 2-6). There is no disclosure of accessing the proprietary database “to obtain transaction information associated with the customer” and certain no disclosure of the “transaction information identifying . . . merchandise having been purchased by the customer in a prior purchase transaction,” as recited in Claim 1. Applicant respectfully submits that these features and operations are completely absent from the disclosure of *Roman*.

As another example, Applicant respectfully submits that *Roman* does not disclose, teach, or suggest “displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise [having been purchased by the customer in a prior purchase transaction]” and “receiving a selection of an item of merchandise from the list from the customer via the web access tool,” as also recited in Claim 1. As disclosed in *Roman*, a customer using the system “clicks on the “Return” or “Customer Service” selection to find the ClicReturns.com icon.” (Page 1, paragraph 14, lines 4-6). “The system then transfers the consumer into the ClickReturns.com environment.” (Page 1, paragraph 14, lines 6-8). Information is then obtained from the consumer and may include “receipt number, consumer’s name, phone number, description of the product being returned matching original transaction record collected from the step above, condition of the product, such as original packaging and working condition.” (Page 1, paragraph 15, lines 1-6). Although *Roman* discloses that “on-line suggestive up-selling techniques” are used to offer the customer a replacement product” (Page 2, paragraphs 17-18), the offering of a replacement product is not analogous to Applicant’s recited steps of “displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise [having been purchased by the customer in a prior purchase transaction]” and “receiving a selection of an item of merchandise from the list from the customer via the web access tool,” as also recited in Claim 1.

Furthermore, Applicant respectfully submits that the deficiencies of *Roman* identified above are not cured by the additional disclosure of *Haseltine*. Rather, the return system disclosed in *Haseltine* uses “a distributed network of point-of-return affiliates who will accept

the e-tailer's returns on a walk-in basis in such associate's brick-and-mortar store." (Page 2, paragraph 18). When the purchaser desires to return the product, the purchaser "is informed by means of any various avenues of media, that the e-tailer participates in an association 40 such that the e-tailer has a distributed network of point-of-return affiliates 42 who will accept the return on a walk-in basis." (Page 3, paragraph 34). Specifically, *Haseltine* states:

The point-of-return associate 42 provides walk-in processing of the primary target's request for return. The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26. Again, the immediate message might actually be a web request for the download of the more full record of the packing slip. However gotten, the *point-of-return associate* calls up the electronic packing slip. Unlike most paper packing slips seen nowadays, this inventive electronic packing slip includes precise information if not instructions to the point-of-return associate. Such information or instructions will guide *this point-of-return associate* on how to properly authorize the return of the given product of this e-tailer.

(Page 3, paragraph 35, emphasis added). Accordingly, *Haseltine* discloses the point-of-return associate obtains an electronic packing slip in response to processing (i.e., scanning) the inventive bar-coded packing slip. There is no disclosure in *Haseltine*, however, of "accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction," as recited in Claim 1. There is also no disclosure of Applicant's steps of "displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise [having been purchased by the customer in a prior purchase transaction]" and "receiving a selection of an item of merchandise from the list from the customer via the web access tool," as also recited in Claim 1. The recited combination of features is absent from the *Haseltine* disclosure.

Dependent Claims 2-5, 7-8, and 10-16 depend upon independent Claim 1 and are not obvious over the proposed *Roman-Haseltine* combination because they include the limitations of independent Claim 1 and recite additional elements that further distinguish the art. Since Claims 2-5, 7-8, and 10-16 incorporate the limitations of independent Claim 1, which Applicant has shown above to be allowable, Applicant has not provided detailed

arguments with respect to Claims 2-5, 7-8, and 10-16. However, Applicant remains ready to do so if it becomes appropriate.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-5, 7-8, and 10-16 that depend from Claim 1.

The Proposed *Roman-Haseltine* Combination is Improper

Assuming for purposes or argument that the proposed combination discloses the limitations of Applicant's claims (which Applicant disputes above), it would not have been obvious to one skilled in the art to make the proposed *Roman-Haseltine* combination. In the Office Action, the Examiner speculates that "it would have been obvious to modify the method of *Roman et al.* to include the merchant specific return rules, the motivation being the ability to accommodate different business practices." (Office Action, page 5). Applicant respectfully submits, however, that the provided motivations do not provide a suggestion to combine these two references.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As discussed above, the very principle and purpose of the system disclosed in *Haseltine* is to provide "a distributed network of point-of-return affiliates who will accept the e-tailer's returns on a walk-in basis in such associate's brick-and-mortar store." (Page 2, paragraph 18). In contrast, the system of *Roman* is designed to provide the customer with a internet enabled reverse logistics processing system. (Page 1, paragraph 14). Specifically, the system of *Roman* provides suggestive up selling techniques such that "[w]hile the customer is processing a return, and before the transaction is complete, ClickReturns.com will immediately offer a similar replacement product for purchase or exchange from the originating retailer." (Page 2, paragraph 17). Because the objectives of the *Roman* and *Haseltine* systems are clearly inconsistent with one another, Applicant respectfully submits

that one of ordinary skill in the art at the time of invention would not have been motivated to modify *Roman* in the manner proposed by the Examiner.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Roman* and *Haseltine*, as identified by Applicant above, evidences the Examiner's reconstruction of Applicant's claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-8 and 10-16 that depend from Claim 1.

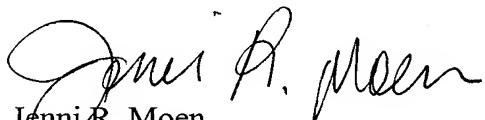
CONCLUSION

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTs L.L.P.
Attorneys for Applicant


Jenni R. Moen
Reg. No. 52,038
(214) 953-6809

Date: April 26, 2006

Customer Number: **05073**